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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,717	06/01/2001	Tara J. Valentin	HANN-0001	1429

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EXAMINER

GRAYSON, ANGELA J

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,717

Applicant(s)

VALENTIN ET AL.

Examiner

Angela J. Grayson, Esq.

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Application filed on 6-01-2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because language such as "is provided" and "present invention provides" is considered language which can be implied. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-7; 9-16; 18-24; 26-63 are rejected under 35 U.S.C. 102(a) as being US Patent No. 6,264,639 by Sauer.
5. As to claims 1, 14, 22, 29, 30, 43, 53, 56, and 60 Sauer discloses an incontinence article comprising a front portion (Figure 1 member 12), a rear portion

joined to the front portion (member 14), and a back guard and front guard extending from the rear portion to a middle back and front portion to a middle chest area respectively of a user and guard extends to a middle area of a user. (col. 5 lines members 66, 62, 64; col. 10 lines 56-60).; a front guard extending from the front portion to a middle chest area of a user (col. 10 lines 33-37); wherein the back guard has a length approximately 1.0 to 10.0 inches (col. 10 lines 17-18) and includes an absorbent material positioned centrally (Figure 5 member 90; col. 16 lines 20-32); wherein the back guard has a vertical and opposing horizontal extensions (Figure 1); wherein the back guard comprises absorbent material and separately positioned elastic about the periphery of the back guard (Figure 5 members 90, 46).

As to claims 2, 38-39, 49 Sauer discloses an incontinence article further comprising tabs for coupling the front portion to the rear portion. (Figure 1 member 50).

As to claims 3-7, 15-16, 23-24, 31-35, 37, 44-47, 50, 54-55, 57-58, 62-63, Sauer discloses an incontinence article wherein the back guard (vertical extension of the back guard) further comprises opposing side portions and a top portion, and wherein elastic is positioned at a predetermined location along a periphery of the back guard; elastic is positioned along the top portion; wherein the elastic is positioned along the side portions; absorbent material is positioned centrally. (Figure 1 member 46, 80, 90).

As to claims 9, 18, 26, Sauer discloses an incontinence article wherein side portions are linear. (Figure 1 see edges adjacent member 50).

As to claims 10 11, 20, 28 41-42, 51-52 and 59 Sauer discloses an incontinence article wherein the back guard has a length of approximately 1.0-10.0 inches; 3.0-10 inches. (col. 10 lines 17-18).

As to claims 12, 19, 27 Sauer discloses an incontinence article wherein the back guard is curved. (Figure 1 member 78).

As to claim 13, Sauer discloses an incontinence article wherein the back guard has a width approximately equal to a width of the rear portion. (Figure 1 member 14).

As to claims 21 and 61, 40, Sauer discloses an incontinence article wherein the back guard (vertical extension of back guard) extends to a middle area of a user. (col. 10 lines 56-60).

As to claims 36, 48 Sauer discloses an incontinence article wherein the back guard has a width greater than a width of the rear portion. (col. 12 lines 6-14).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 8, 17, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer.

As to claims 8, 17, 25 Sauer discloses an incontinence article but fails to disclose wherein the side portions are curved. However, Sauer discloses various changes and modifications may be made without departing from the spirit of the invention (col. 16 lines 33-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the linear edges of the waist guard of Sauer to include curved edges since a curved edge may be considered to be an ornamental changed affecting only the esthetics of the invention rather than the scope.

Double Patenting

9. The nonstatutory obviousness-type double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory obviousness-type double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10,081,938. Although the conflicting claims are not identical, they are not patentably distinct from each other because Both claim an back guard for an absorbent article, however, Application No. 10,081,938 is directed to a guard with a "bumper" attached. A "bumper" can be any material added to create a spacer. The absorbent material claimed in the instant application performs the same function. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the absorbent contained in the instant application serve the dual role of bumper as in Application No. 10,081,938 since both have spacing capabilities.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Nos. 6,132,410 ; 5,833,677 ; 5,520,674 ; 5,514,121 ; 5,026,364 ; 6,258,076 ; 6,425,889 ; 5,938,652.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela J. Grayson, Esq. whose telephone number is 703-305-1806. The examiner can normally be reached on Monday-Thursday from 9:30 am to 7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on 703-305-1025. The fax phone numbers


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for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

Angela J. Grayson, Esq. *Agm*
December 3, 2002


JOHN S. CALVERT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700